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REMARKS

Applicants have carefully considered the September 2, 2005 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 1-29 were pending in this application. In response to the Office Action dated September 2, 2005, claims 7, 16 and 28 have been recast in independent form. The specification at page 8 has been amended to correct a typographical error. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification. Applicants submit that the present Amendment does not generate any new matter issue. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

The Examiner objected to the disclosure for an apparent informality on page 8. Applicants have amended the specification at page 8 to correct the obvious typographical error regarding FIG.2. Accordingly, the Examiner is requested to reconsider and withdraw the objection.

Claims 1-6, 15, 26 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McCay (U.S. Pat. No. 6,283,276, hereinafter "McCay") in view of Laxo (U.S. Pat. No. 2,455,127, hereinafter "Laxo"). The Examiner asserted that McCay discloses the envelope insert conveyor assembly of claim 1, but for a gripping element disposed

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adjacent to an indented portion. The Examiner asserted that Laxo discloses gripping element 33 disposed adjacent an indented portion 29. The Examiner concluded that it would have been obvious to include such a gripping element onto McCay's holder 40 because it would allegedly keep the conveyed articles from sliding off to the side. Applicants respectfully traverse.

Independent claim 1 describes, in pertinent part, an envelope insert conveyor assembly that comprises a gripping element disposed adjacent an indented portion of one of the paired sidewalls and biased toward an interior surface of the indented portion. Independent claim 26 describes, *inter alia*, a pusher member for conveying an envelope insert, wherein one of the generally U-shaped indented portions comprises a gripping element having a gripping member which is resiliently biased toward an interior surface of the indented portion.

McCay, which is discussed in background section of the present application at pages 1-3, discloses a plurality of pusher elements 40 are attached to conveyor chains 30 at a fixed spaced-apart distance. Each pusher element has a lower portion 40a for supporting the bottom of a sheet(s) and an indented portion 40b for receiving the rear portion of sheet(s) and pushing the same in paper feed direction F. McCay provides a guide 100 to control the degrees of freedom of movement allowed of pusher 40 and for assuring that pusher element 40 moves only in the X direction with no deflection in the Y or -Z directions. Guide 100 comprises a guiding element 50 of a selected cross-sectional shape (e.g., a circular cross-section). Sidewalls 42 of the pushers 40 are configured to straddle the respective guiding element 50. Thus, McCay is silent as to any gripping element disposed near indented portion 40b. Rather, McCay desires to control the degree

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of freedom of movement allowed of pusher 40 to control sheet skew and, therefore, does not disclose or remotely suggest a pusher finger guide that reduces the opportunity for sheet skew, as disclosed in the present specification.

Laxo is directed to a conveyor gripper member for can bodies and the like. In contrast, McCay is directed to an apparatus for handling sheets and, therefore, the references are completely unrelated in terms of the type of material their respective gripping members engage and advance. Indeed, Laxo, at col. 1, lines 28-33, provides a conveyor gripping member for propelling a can body along a path and prevents the turning of the can body about its axis by insuring a positive locking of the can to the conveyor.

It is well established that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge readily available to one of ordinary skill in the art. Applicants submit that the Examiner's asserted motivation to modify McCay in view of Laxo is not found in either McCay or Laxo. Instead, the Examiner improperly relies on the benefit of hindsight using Applicants' own disclosure. Applicants' own disclosure, however, is forbidden territory for the Examiner to obtain the requisite motivation for combining the applied prior art. *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985). Accordingly, for the reasons set forth above, Applicants submit that the Examiner has not established a *prima facie* basis to deny patentability to the claimed subject matter under 35 U.S.C. § 103 for lack of the requisite

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factual basis and lack of the requisite realistic motivation. Thus, the rejection should be withdrawn.

Applicants gratefully acknowledge the Examiner's indication of allowable subject matter. Claims 7-14, 16-25, 28 and 29 were objected to as being dependent upon a rejected base claims, but would be allowable if recast in independent claim form. Applicants have rewritten claim 7 in independent form to include the limitations of claim 1; claim 16 has been written in independent form to include the limitations of claims 1 and 15; and claim 28 in independent form to include the limitations of claim 26. As such, Applicants submit that claims 7-14, 16-25 and 28-29 are now in immediate condition for allowance.


It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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